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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

JOBY, INC.,

Plaintiff,

v.

TOCAD AMERICA, INC.,

Defendant.

Case No. 3:07-cv-06455-SI

**DEFENDANT'S MEMORANDUM IN  
SUPPORT OF MOTION FOR SUMMARY  
JUDGMENT**

**[REDACTED PUBLIC VERSION OF  
DOCUMENT SUBMITTED UNDER SEAL]**

DEFENDANT'S MEMORANDUM IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

Case No. 3:07-cv-06455-SI

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## INTRODUCTION

This is a straightforward trade dress case involving a simple product, a flexible tripod. Significantly, Tocad has agreed to stop selling the products at issue (two models of its flexible tripod) in this litigation as of May 30, 2008 and July 15, 2008. (McMillion Decl., Ex. A, Dkt. 62, Stipulation re Joby's Motion for Preliminary Injunction). Hence, any alleged damages incurred by Joby will have been capped. Moreover, this is not a case that involves a significant amount of money—indeed Joby's initial Gorillapod was introduced in February 2006 and Tocad's first flexible tripod product came on the market in October 2006. (McMillion Decl. ¶¶3, 4). Yet, incredibly even though Tocad has already agreed to discontinue its sales, Joby is intent on vigorously pursuing this litigation. Obviously, Joby would only be entitled to any damages if it can establish a trade dress in the first instance, which as set forth herein, it cannot do.<sup>1</sup> Hence, in an effort to stem the flow of the unnecessary expense of litigation, this case can and should be resolved now on summary judgment. The existing record of Joby's extensive preliminary injunction filings,<sup>2</sup> Joby's own advertising and promotional documents and the utility patent applications filed by Joby on substantially all the same features it now claims as its trade dress, provide a sufficient basis for this Court to determine whether Joby can satisfy its burden to establish that the features it claims as its trade dress are nonfunctional and, if so, whether the Gorillapod acquired secondary meaning in the eight short months it was on the market prior to the entry of the Flexpod and other competitors.

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<sup>1</sup> As reflected in Ex. C to the McMillion Declaration, Tocad's gross profits on these products are significantly less than what the legal fees will likely be to continue litigating this matter.

<sup>2</sup> Within two weeks of serving the Complaint on Tocad, Joby filed a motion for preliminary injunction which included a 24 page memorandum and six declarations which attached nearly forty exhibits. (Dkt. 11-18). The preliminary injunction was resolved by Stipulation and taken off calendar. (Dkt. 61, 62).

1           **STATEMENT OF ISSUES**

2           1.       Whether the features Joby claims as its trade dress are nonfunctional.

3           2.       Whether the Gorillapod acquired secondary meaning in the eight months it was on  
4 the market prior to the entry of the Tocad Flexpod.

5           **I.       STATEMENT OF FACTS**

6           **A.       Characteristics of the Gorillapod**

7           Joby introduced the Gorillapod flexible tripod for sale in February 2006. (McMillion  
8 Decl., Ex. D, Bevirt Decl. ¶5).<sup>3</sup> Joby promotes the advantages of the Gorillapod tripod in that (1)  
9 it has “flexible joints that bend and rotate 360° to form the perfect shape,” (2) “you can bend and  
10 twist them and they’ll always keep your camera steady,” (3) the Gorillapod “firmly secures your  
11 camera to just about anything - anywhere and everywhere,” and (4) its “soft rings and rubberized  
12 feet prevent your Gorillapod from slipping in even the toughest environments.” (www.joby.com)  
13 (Excerpts attached to McMillion Decl., Ex. E). Additionally, Joby’s “Product Overview”  
14 contains many of the same statements, in addition to statements that the product (1) “[f]eatur[s]  
15 over two dozen flexible leg joints that bend and rotate,” (2) it is the “only tripod malleable  
16 enough to provide you with the perfect shot while wrapped around a tree branch, hanging from a  
17 pole, or perched on a jagged rock,” and (3) that its “[r]ubberized ring and foot grips provide extra  
18 gripping power to grapple wherever you want to go.” (McMillion Decl., Ex. F)<sup>4</sup> The Product  
19 Overview *only* addresses the functionality of the Gorillapod product. Similarly, many of the  
20 articles written about or reviewing the Gorillapod tout these functional features. (McMillion  
21 Decl., Ex. D, Bevirt Decl. Ex. G). These are the very same elements that Joby claims constitute  
22 its protectible trade dress:

23                     Joby’s distinctive design includes, but is not limited to the non-  
24                     functional aspects of multiple rounded segments (or “balls”)

25                     <sup>3</sup> JoeBen Bevirt, the founder and President of Joby, Inc. submitted a Declaration in  
26 support of Joby’s Motion for Preliminary Injunction. That Declaration is attached as Ex. D to the  
McMillion Declaration.

27                     <sup>4</sup> The Product Overview also touts the functionality through identical statements which  
28 appear on the website: “firmly secure your compact digital camera to virtually any surface –  
anywhere and everywhere” and “flexible joints bend and rotate 360° to form the perfect shape.”  
(Compare McMillion Decl., Ex. E with McMillion Decl., Ex. F).

1 appearing in a “chain,” “string” or series arrangement for each leg  
2 of the tripod, with each segment having a ring around the middle.

3 (Compl. ¶ 8).

4 In its answers to interrogatories, Joby expanded its claim of alleged trade dress as follows:

5 The Gorillapod has a body section and three legs made of rounded  
6 segments (or “balls”) connected together. Each of the segments in  
7 the legs has a ring around the middle in a color that contrasts with  
8 the color of the segment, and each segment ends in a “rounded  
foot.” The rounded body, the rounded leg segments, the rounded  
feet, the proportions that Joby selected for the body, legs and feet,  
and the contrasting rings give the tripod a playful striped look.

9 (McMillion Decl., Ex. G, Joby’s Answers to Int. No. 2).

10 Joby has asserted that “the legs and feet...are the key features of the Gorillapod trade  
11 dress.” (Dkt. 11 - PI Mem. at 19). Moreover, Joby has claimed that various iterations of Tocad’s  
12 attempts at redesigning a flexible tripod, including different shape segments, different color  
13 schemes and different shape feet, still come within the ambit of Joby’s alleged trade dress.  
14 (Examples of Tocad’s redesign efforts that were rejected by Joby as unacceptable are attached to  
15 the McMillion Decl. as Ex. H).

16 Initially, the Gorillapod was black with gray rings and feet. (McMillion Decl., Ex. D,  
17 Bevirt Decl., Ex. A). In or about August 2007, Joby introduced color versions of the Gorillapod  
18 wherein the body and the segments remain black and Joby added color to the circumferential  
19 rings and feet. (McMillion Decl., Ex. I).

20 **B. Joby’s patent filings**

21 On January 3, 2006, Joby filed an application for a utility patent in connection with its  
22 flexible tripod. (McMillion Decl., Ex. J “the 2006 Parent Application”). On May 9, 2007, Joby  
23 filed a continuation application which published on September 13, 2007. (McMillion Decl., Ex.  
24 K “the 2007 Continuation Application”). The 2006 Parent Application published on July 5, 2007  
25 and in an Office Action dated January 25, 2008, the USPTO rejected all claims in a final rejection  
26 on the basis of prior art, including the disclosure that Bevirt “came up with the idea for a flexible  
27 tripod with rotating joints that would allow the tripod to be used in locations where conventional,  
28 rigid-leg tripods could not be used.” (McMillion Decl. Ex. D, Bevirt Decl. ¶2). (McMillion



Decl., Ex. L).<sup>5</sup> Claim 1 of the 2006 Application claims an “apparatus” with “a plurality of flexible legs,” an “interconnect portion” and a “clip removably attached to said interconnect portion.” (McMillion Decl., Ex. J). In essence, Claim 1 claims a flexible apparatus with legs but without any particular construction. Claim 2 claims the ball and socket construction. (McMillion Decl., Ex. J). Claim 5 adds the circumferential ring. (McMillion Decl., Ex. J). Figure 7 of the 2006 Application “illustrates a tripod apparatus according to some embodiments of the present invention.”

The specification describes Figure 7 in relevant part as follows:

A body portion provides a base of support for three flexible legs. The flexible legs consist of a series of interconnected ball and socket joint connectors. The flexible legs are able to be flexed into a variety of positions and can be used to support the body portion by forming tripod support. The flexible legs are able to adapt to uneven surfaces to allow the tripod to function in a variety of situations.

\* \* \* \*

Although the flexible legs are illustrated as functioning legs in FIG. 7, the legs are of sufficient flexibility that they may be used to wrap around items such as bars or other objects in order to fasten the tripod apparatus to objects that would not be suitable for mounting of a typical tripod. In conjunction with the gripping portion, this allows the tripod apparatus to be fastened to a variety of objects. For example, when used to position a digital camera, the legs may wrap around a vertical gate rail, allowing the mounting of the camera for a photo taking opportunity not previously available.

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<sup>5</sup> JoeBen Bevirt filed a Declaration with the USPTO in which he indicated that “an apparatus” was publicly displayed at Stanford University in the Spring 1996 as part of a class presentation. (McMillion Decl., Ex. L). In that Declaration, Bevirt stated that the “apparatus consisted of a tripod with flexible legs. The tripod legs utilized a series of connectors having ball and socket features. The connectors had a groove machined into their outer periphery and an O-ring was placed in the groove. At the top of the tripod a threaded stud was embedded therein.”



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///

The Gorillapod is a commercial embodiment of Fig. 7 of the utility patent application.

### Commercial Embodiment<sup>6</sup>



### Patent Embodiment

Patent Application Publication Jul. 5, 2007 Sheet 8 of 14 US 2007/0154254 A1

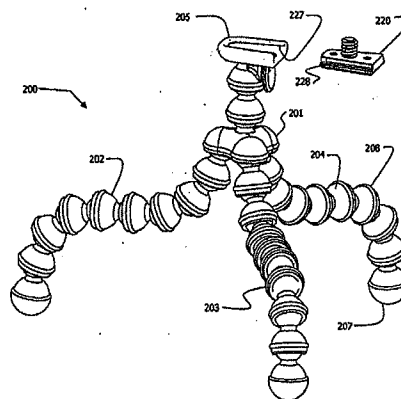


FIGURE 7

As the Court may be aware, the patent prosecution process entails a lot of back and forth between the applicant and the patent examiner. Many times this cross communication results in the rejection of claims, revisions and amendments to claims, and the filing of continuation applications for certain portions of a claimed invention. See Roger E. Schechter & John R. Thomas, *Principles of Patent Law* § 7.2.3 (2d ed. 2004). Notably in this case, Joby had engaged in such communication setting forth substantial evidence of the functionality of the Gorillapod. On July 7, 2007 in response to a rejection of claims in the 2006 Parent Application, Joby amended its claims to include a “*spherical* socket engaging end surface at said first end portion, said *spherical* engaging end surface being the external surface at said first end portion.” (McMillion Decl., Ex. M, Claims 18, 25) (emphasis added). In essence, Joby was adding a claim for the spherical shape of the tripod segments in order to defeat prior art. Further on February 22,

<sup>6</sup> This photograph of the Joby Gorillapod was downloaded from the Magellan’s Travel Supplies website. [http://www.magellans.com/store/Audio\\_\\_\\_Photo\\_\\_\\_Photo\\_AccessoriesPH102?Args=](http://www.magellans.com/store/Audio___Photo___Photo_AccessoriesPH102?Args=) (last accessed June 19, 2008).

1 2008 in a subsequent response to a rejection of claims, Joby amended its claims to specifically  
 2 identify “a plurality of connector bodies adapted for use in the leg of a camera tripod...” and  
 3 added new claims for “[a] camera tripod leg, comprising a plurality of couple connector  
 4 bodies...” (McMillion Decl., Ex. M, Claims 11, 18, 26). Interestingly here, Joby was attempting  
 5 to patent the entire flexible tripod leg for its functional purposes.<sup>7</sup> These claims are still pending  
 6 and the patent examiner has not reached a final determination on their validity.

7 Notwithstanding that no patent has issued on either the 2006 Parent Patent Application or  
 8 the 2007 Continuation Application, the existence of these utility patent applications is notable for  
 9 at least two reasons: (1) the utility patent applications claims the spherical ball and socket used in  
 10 the Gorillapod and the ring around the segments characterized as “a gripping portion comprising  
 11 a circumferential ring” (McMillion Decl., Ex. J); and (2) Joby has touted the fact that its  
 12 applications published to Toca and its customers threatening potential litigation: “continued use,  
 13 sale, offer for sale, making, or importation of the knock-off product risks a potential liability for a  
 14 royalty up through the time of the patent’s issuance. *See* 35 U.S.C. § 154(d).” (McMillion Decl.,  
 15 Ex. O).<sup>8</sup>

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24 \_\_\_\_\_  
 25 <sup>7</sup> Not surprising, in the 2007 Continuation Application Joby attempts to claim the features  
 26 of the Gorillapod in their entirety. Claims 15, 16 and 20 specifically claim a tripod “suitable for  
 27 supporting a camera” which has “three flexible legs” “composed of a multiplicity of connector  
 28 pieces that join together in a ball and socket joints that permit pivotal movement between  
 connecting ball and socket components to together provide each leg with sufficient flexibility to  
 substantially wrap around an object.” (McMillion Decl., Ex. N, Claims 15, 16, 20)

<sup>8</sup> This letter is also relied on by Joby in its Motion for Preliminary Injunction. *See*  
 DeMarchi Decl. in Support of Joby’s Motion for Preliminary Injunction, Ex. I.

The following table compares some of Joby's utility patent application claims, trade dress assertions and advertising statements<sup>9</sup>:

2006/2007 Patent Application	Alleged Trade Dress	Joby's Advertising Statements
<p>Ball and socket connectors. (2006 Application Claim 2)</p> <p>Spherical sockets. (2006 Application Claim 18, 25)</p> <p>Three flexible legs composed of a multiplicity of connector pieces that join together in ball and socket joints. (2007 Continuation Application Claim 16)</p> <p>Leg with sufficient flexibility to substantially wrap around an object. (2007 Continuation Application Claims 16, 20, 21)</p>	<p>Multiple rounded segments (or "balls") appearing in a "chain", "string" or series of arrangements for each leg. (Compl. ¶8)</p> <p>"legs made of rounded segments (or "balls") connected together." (Ans. to Interrogatory No. 2)</p>	<p>30 or more articulating ball-and-socket joints. (www.joby.com)</p> <p>Flexible Joints bend and rotate. (Doc. Prod. JOBY000150)</p> <p>Legs bend and rotate 360 degrees... You can wrap the Gorillapod around a tree branch. (Doc. Prod. JOBY000072, 000075, 000078)</p>
<p>Gripping portion is a circumferential ring on connector. (2006 Application Claims 5, 14)</p>	<p>"each segment having a ring around the middle." (Comp. ¶ 8)</p>	<p>soft rings prevent your Gorillapod from slipping. (www.joby.com)</p> <p>Ring &amp; Foot Grips provide extra gripping power (Doc. Prod. JOBY000150)</p>
	<p>Each segment ends in a rounded foot. (Ans. to Interrogatory No. 2)</p>	<p>rubberized feet prevent your Gorillapod from slipping. (www.joby.com)</p> <p>Ring &amp; Foot Grips provide extra gripping power. (Doc. Prod. JOBY000150)</p> <p>Rubbery feet provide extra gripping power. (Doc. Prod. JOBY000072, 000075, 000078)</p>

<sup>9</sup> All documents referred to in this table are exhibits to the McMillion Declaration.

As will be demonstrated herein, the primary features of what Joby's claims comprise its trade dress are functional and, therefore cannot constitute protectible trade dress as a matter of law.

### C. History of Tocad's Flexible Tripod

In or about October 2006, Tocad introduced its flexible tripod, the Flexpod, which also contained the ball and socket construction with a rubberized ring around the circumference of the segments. (McMillion Decl. ¶4). At the time that Tocad began selling the Flexpod unit, Joby did not have any published patent applications and the Gorillapod had only been on the market for approximately eight months. There is no dispute that the Tocad Flexpod is similar to Joby's Gorillapod and there is no dispute that Tocad was aware of the Gorillapod in developing the Flexpod unit.<sup>10</sup> The Flexpod unit was sold in packaging which clearly displayed the Sunpak brand name. (McMillion Decl., Ex. P). Tocad sells a variety of camera accessories under the Sunpak brand, including different types of tripods (other than flexible tripods), flash accessories, consumer and professional flash units, video lights, filters, conversion lenses, professional studio lighting systems, batteries and chargers. (McMillion Decl., Ex. Q).

On September 6, 2007 Joby provided "formal" notice to Tocad that "Joby's patent application No. 2007/0154254 has been published." Accordingly, "any continued use, sale, offer for sale, making, or importation of infringing products risks potential liability for a royalty up through the time of the patent's issuance." (McMillion Decl., Ex R)<sup>11</sup>. In subsequent correspondence as well as in this lawsuit, Joby has asserted that Tocad's Flexpod also infringes Joby's trade dress. In an attempt to avoid this brewing dispute, Tocad redesigned its flexible tripod product and introduced a new version, the Flexpod Plus, in or about October 2007.

<sup>10</sup> It is likely that Joby will expend much effort describing Tocad as a "copycat" and the Flexpod as a "knock-off." However, as will be set forth herein, copying is legitimate competition where, as here, there is no intellectual property protection. Hence, Joby's repeated claims of "copycat" or "knock-off" are a red herring. See e.g. *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) and cases cited *infra* at 18, 21.

<sup>11</sup> Joby sent similar letters to Tocad and its customers after the Continuation Patent Application published. (McMillion Decl., Ex. S). Notably, Joby relies on all of these letters in its Motion for Preliminary Injunction. See DeMarchi Decl. Exs. H, I, M.

(McMillion Decl., Ex. T, Dkt. 11 - PI Mem. at 9). As noted by Joby, the Flexpod Plus product did not have the ball and socket construction but rather had a flexible aluminum core in each leg “thus avoiding some of the patent issues.” (Dkt. 11 - PI Mem. at 3). The segments were also not round but of a “flower pot” type shape. (McMillion Decl., Ex. T). The Flexpod Plus still had the ring around the segments but it was placed in the inner portion of the segments as opposed to the outermost circumference. It also had a completely different interconnect portion and attachment clip. (McMillion Decl., Ex. T). Despite all these differences, Joby claims that the Flexpod Plus still infringes its alleged trade dress. (Compl. ¶11).

By Stipulation entered on May 6, 2008, in an attempt to avoid protracted litigation and resolve Joby’s Preliminary Injunction Motion, Tocad agreed to stop selling Flexpod and Flexpod Plus units by May 30, 2008 and July 15, 2008 respectively.<sup>12</sup>

## II. ARGUMENT

### A. Standards on Summary Judgment

It is axiomatic that summary judgment is proper when the “pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and the moving party is entitled to summary judgment as a matter of law.” *Microsoft Corp. v. EEE Business, Inc.*, 2008 WL 1990809, at \*2 (N.D. Cal. May 5, 2008). Further, “[a] principal purpose of the summary judgment process is to identify and dispose of factually unsupported claims.” *Id.* “A dispute about a material fact is ‘genuine’ if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986) (“Only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.”). Because Plaintiff bears the burden of proof, it must designate “specific facts” showing that there is a genuine issue of material fact. *Global Manufacture Group, LLC v.*

<sup>12</sup> Joby has taken the position that while the Stipulation allows Tocad to continue selling to its customers through the identified dates, Joby can still pursue the customers to whom Tocad is selling these products. Tocad believes that this position is contrary to the letter if not the spirit of the Stipulation and that Joby’s conduct in contacting Tocad’s customers is improper. (Dkt. 69 - June 2, 2008 Joint Letter to the Court).

1 *Gadget Universe.com*, 417 F. Supp. 2d 1161, 1155-56 (S.D. Cal. 2006). Significantly, “the  
 2 moving party has no burden to negate or disprove matters on which the opponent will have the  
 3 burden of proof at trial.” *Novell, Inc. v. Weird Stuff, Inc.*, 0094 WL 16458729, at \*7 (N.D. Cal.  
 4 Aug. 2, 1993). The summary judgment standard evaluates “whether the evidence presents a  
 5 sufficient disagreement to require submission to a jury or whether it is so one-sided that one party  
 6 must prevail as a matter of law.” *Anderson*, 477 U.S. at 252. Conversely, “[i]f the evidence is  
 7 merely colorable, or is not significantly probative, summary judgment may be granted.” *Id.* at  
 8 249-50. Joby will be unable to satisfy its burdens in this case and summary judgment should be  
 9 granted in Tocad’s favor.

10 **B. There is No Genuine Issue of Material Fact that the Gorillapod Does Not**  
 11 **Have a Protectible Trade Dress**

12 This case is ripe for summary judgment as the allegations of Joby’s Complaint, its  
 13 Answers to Interrogatories, its previous preliminary injunction submissions, and its published  
 14 utility Patent Applications demonstrate that as a matter of law, the Gorillapod does not have a  
 15 protectible trade dress. The determination of whether Joby has a protectible trade dress does not  
 16 require discovery from Tocad—information regarding the functionality of the Gorillapod features  
 17 can be gleaned from Joby’s own documents and publicly available information.

18 The “trade dress of a product is essentially its total image and overall appearance.”  
 19 *Global*, 417 F. Supp. 2d at 1166. However, “trade dress protection may not be claimed for  
 20 product features that are functional.” *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S.  
 21 23, 29 (2001). A person asserting trade dress protection has the burden of establishing that the  
 22 matter sought to be protected is not functional and that it has acquired secondary meaning. 15  
 23 U.S.C. §1125(a)(3); *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 214 (2000).  
 24 While functionality is a question of fact, it can be decided on summary judgment. *Global*, 417 F.  
 25 Supp. 2d at 1167 (citing *Disc Golf Ass’n, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th  
 26 Cir. 1998)); *Vision Sports, Inc. v. Melvill Corp.*, 888 F.2d 609, 614 (9th Cir. 1989). Moreover,  
 27 *secondary meaning must exist before the alleged infringement began. Braun Inc. v. Dynamic*  
 28



1 *Corp. of America*, 975 F.2d 815, 826 (Fed. Cir. 1992) (emphasis added); *Levi Strauss & Co. v.*  
 2 *Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985); *Continental Laboratory Products, Inc. v.*  
 3 *Medax International, Inc.*, 114 F. Supp. 2d 992, 1002 (S.D. Cal. 2000). Here, Joby cannot  
 4 establish either element as a matter of law and therefore, summary judgment should be granted in  
 5 Defendant's favor.

6 **1. Joby cannot prove that its trade dress is non-functional**

7 In order to determine whether a product's trade dress is functional, courts consider several  
 8 factors: (1) whether the design yields a utilitarian advantage; (2) whether alternative designs are  
 9 available; (3) whether advertising touts the utilitarian advantages of the design; and (4) whether  
 10 the particular design results from a comparatively simple or inexpensive method of manufacture.  
 11 *Talking Rain Beverage Co., Inc. v. South Beach Beverage Co.*, 349 F.3d 601, 603 (9th Cir. 2003);  
 12 *Switchmusic.com, Inc. v. U.S. Music Corp.*, 416 F. Supp. 2d 812, 820 (C.D. Cal. 2006). "None of  
 13 these factors is dispositive and all should be considered collectively." *Id.* Most, if not all of these  
 14 factors mandate a finding of functionality in this case. It is Joby's burden to prove that the  
 15 features it claims as its trade dress are nonfunctional. *TrafFix*, 532 U.S. at 29. Significantly,  
 16 "[b]ecause affording trade dress protection to product designs may hinder legitimate competition;  
 17 the Ninth Circuit has advised district courts to evaluate such claims with greater scrutiny than  
 18 claims involving other forms of trade dress." *Continental Lab.*, 114 F. Supp. 2d at 997. Indeed,  
 19 as the Supreme Court noted in the *TrafFix* case, "in *Wal-mart*, we were careful to caution against  
 20 misuse or over extension of trade dress. We noted that 'product design almost invariably serves  
 21 purposes other than source identification.'" *TrafFix*, 532 U.S. at 29 (quoting *Wal-Mart Stores,*  
 22 *Inc.* 529 U.S. at 213). Accordingly, Joby's alleged trade dress must be carefully described and  
 23 narrowly construed.

24 **a. The Gorillapod design features are functional**

25 Joby admits and it is clear that "a product feature is functional and cannot serve as a  
 26 trademark, if it is essential to the use or purpose of the article or it affects the quality of an  
 27 article." *Eppendorf-Netheler Hinz GMBH v. Ritter GMBH RK*, 289 F.3d 351, 355 (5th Cir. 2002)  
 28



(quoting *TrafFix*, 532 U.S. at 29); (Dkt. 11 - PI Mem. at 14). Significantly, if the product feature “is the reason the device works, then the feature is functional.” *TrafFix*, 532 U.S. at 34. Further, “a utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection.” *Id.* at 29-30. In explaining the different protections of the Lanham Act and patent law, the Supreme Court in *TrafFix* further noted that:

[t]he Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller. The Court of Appeals erred in viewing MDI as possessing the right to exclude competitors from using a design identical to MDI’s and to require those competitors to adopt a different design simply to avoid copying it. MDI cannot gain the exclusive right to produce sign stands using the dual spring design by asserting that consumers associate it with the look of the invention itself. Whether a utility patent has expired or there has been no utility patent at all, a product design which has a particular appearance may be functional because it is “essential to the use or purpose of the article” or “affects the cost or quality of the article.”

*TrafFix*, 532 U.S. at 34-35 (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 (1982)).

Based upon these standards and legal principles, Joby cannot establish that features it claims as its trade dress are nonfunctional. Joby describes its trade dress as follows:

The Gorillapod has a body section and three legs made of rounded segments (or “balls”) connected together. Each of the segments in the legs has a ring around the middle in a color that contrasts with the color of the segment, and each segment ends in a “rounded foot.” The rounded body, the rounded leg segments, the rounded feet, the proportions that Joby selected for the body, legs and feet, and the contrasting rings give the tripod a playful striped look.

(McMillion Decl., Ex. G, Joby’s Ans. to Int. No. 2).

Joby has previously claimed most of these product features are functional. The so-called “rounded segments (or ‘balls’) connected together” refers to the “spherical” ball and socket

1 construction of the Gorillapod and the “ring around the middle” is the “gripping portion  
 2 comprising a circumferential ring,” both of which are claimed in the utility patent application.<sup>13</sup>  
 3 (McMillion Decl., Ex. J). Given the duty of candor required in patent applications, these features  
 4 must be considered to be functional by Joby. Indeed, Joby has threatened patent litigation in  
 5 connection with these features.<sup>14</sup> Moreover, Joby chose to have its trade dress contain precisely  
 6 the same elements for which it is seeking utility patent protection, namely the “spherical” ball and  
 7 socket construction and the circumferential ring as the “overall look.” Joby could have utilized a  
 8 different appearance for its Gorillapod rather than the functional features identified in its utility  
 9 patent. Joby cannot have it both ways—i.e. claim spherical ball and socket construction in its  
 10 utility patent and use the ball and socket “overall look” as its trade dress.

11 These same features are also touted by Joby as the reason that the Gorillapod works: the  
 12 “flexible joints bend and rotate 360° to form the perfect shape” and the “soft rings and rubberized  
 13 feet prevent your Gorillapod from slipping in even the toughest environments.” (www.joby.com)  
 14 (McMillion Decl., Ex. E). While the “rounded foot” is not mentioned in the utility patent  
 15 application, it is actively promoted by Joby as performing the function of “prevent[ing] the  
 16 Gorillapod from slipping.” (www.joby.com) (McMillion Decl., Ex. E). Further, the Joby Product  
 17 Overview, only focuses on the functional features of the design. (McMillion Decl., Ex. F).  
 18 Additionally, these features are also mentioned in the reviews and other articles written about the  
 19 Gorillapod as being key to the way in which the Gorillapod works:

- 20 • **Digital Photography**, 8/29/07, *Grip Like a Gorilla*—“this flexible little wonder is  
 21 covered with rubberized joints that help make it grip to most anything that you  
 22 wrap it around. That dexterity allows me to use most anything—a chair, lamppost,  
 stair rail or tree limb—as a secure mount for my digital point and shoot.”
- 23 • **Calumet Photographic**, July 2007, *The World is Your Tripod*—“Each model [of  
 24 the Gorillapod] has round rubber shoes at the bottom of its three legs and a rubber  
 25 ring around each bulbous joint, several of which make up the legs. The rubber is

26 <sup>13</sup> Note that whether or not the patent ultimately issues, statements made to the  
 27 USPTO are subject to the duty of candor and must be truthful. See 37 C.F.R. §1.56 (Rule 56 –  
 28 Duty of Candor and Good Faith); see also *Elk Corp. of Dallas v. GAF Bldg. Materials Corp.*, 168  
 F.3d 28, 30 (Fed.Cir.1999).

<sup>14</sup> Patent infringement is obviously evidence of functionality. *TrafFix*, 532 U.S. at 31-32.

key. Friction and gravity have everything to do with placing a camera and Gorillapod.”

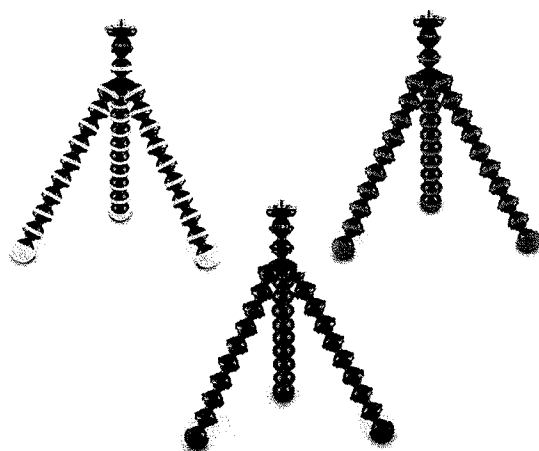
- **Bachelor Guy**, 6/13/07, *Got a Click-Happy Dad?*—“this tripod is made of 30 or so rubber-coated ball and socket joints that can bend and twist into just about any shape, gripping on to whatever dad needs to get his shot.”
- **Onboard Snowboarding**, 09/05/06, *Onboard Downtime, Gorillapod*—“Each of the grippy ball & socket joints on the legs is able to bend and rotate 360 degrees. The base joints also have larger grips, so the tripod can stand in the traditional manner without slipping.”
- **Pocket-Lint-Gadget News and Reviews**, 08/20/06, *Want to take pictures anywhere? This might be just the answer*—“Each of the Gorillapod’s legs are articulated along their entire length using small ball and socket joints that allow the entire leg to move and swivel in any direction. Each articulation can rotate through 360-degrees and a rubberized gripping rib rings each socket part of each joint. Add to the ensembles rubberised feet and Gorillapod can grip on uneven, rough or vertical surfaces allowing the Gorillapod to be positioned anywhere while keeping the camera level.”

(See McMillion Decl., Ex. D, Bevirt Decl., Ex. G).

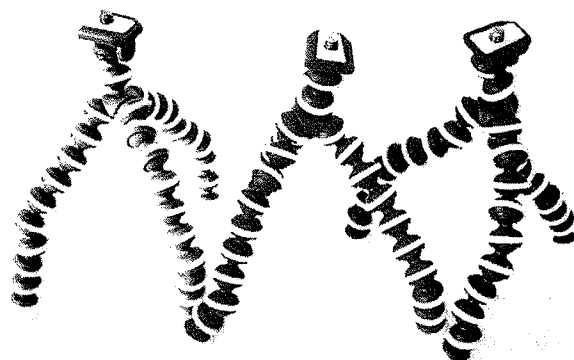
Additionally, to the extent Joby claims that trade dress feature of the “circumferential ring” which is the “gripping portion” is its contrasting color, that feature alone cannot save Joby’s claimed trade dress from the functionality realm.<sup>15</sup> First, Joby cannot claim protection in the use of “contrasting colors.” *Keystone Camera Products Corp. v. Ansco Photo-Optical Products Corp.*, 667 F. Supp. 1221, 1229 (N.D. Ill. 1987). In *Keystone Camera*, the Court noted that to “grant plaintiff trade dress protection for combinations of unspecified contrasting colors would allow the plaintiff to monopolize all combinations of contrasting colors.” *Id.* Moreover, in cases in which trademark or trade dress protection has been allowed for colors or combinations of colors, those colors or color combinations have been specifically defined. *See e.g. Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995) (green-gold color of press pads protectible). Here, Joby is claiming protection in *the idea* of contrasting colors—that is not protectible. Further, the overbreadth of Joby’s claim is best illustrated by the different use of color by Joby and Tocad. Joby uses black as the color of its tripods with the rings and feet in a different color

<sup>15</sup> As noted however, the trade dress claimed by Joby includes far more than just the rings around the middle in contrasting colors.

such as red, green or yellow. (McMillion Decl., Ex. I). Tocad on the other hand varies the color of the tripod and the rings and feet are in a lighter color. (McMillion Decl., Ex. U).



**Gorillapod Colors**



**Flexpod Colors**

Interestingly, Tocad was first to market with colors other than the black tripod with gray or ivory accents.<sup>16</sup> Moreover, “[f]or an overall product configuration to be recognized as a trademark, *the entire design* must be nonfunctional.” *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 516 (9th Cir. 1989) (emphasis added). Hence, even if the contrasting colors were a protected nonfunctional feature, that does not render the entire Gorillapod design nonfunctional. Additionally, Joby cannot simply claim that these individual functional features are combined in an arbitrary way so that the “total image” or “overall appearance” is nonfunctional:

[W]here the whole is nothing other than the assemblage of functional parts, and where even the arrangement and combination of the parts is designed to result in superior performance, it is semantic trickery to say that there is still some sort of separate ‘overall appearance’ which is nonfunctional.

*Leatherman Tool Group Inc., v. Cooper Industries, Inc.* 199 F.3d 1009, 1013 (9th Cir. 1999); *Antioch Co. v. Western Trimming Corp.*, 347 F.3d 150, 158 (6th Cir 2003).

<sup>16</sup> Tocad first introduced the Flexpod in colors in November 2006, just one month after entering the market. Joby, however, did not sell any colored units until August 2007, nine months after Tocad had already been doing so. (See McMillion Decl. ¶ 3-4, Exs. B, C). Moreover, even Tocad’s original Flexpod had a different color scheme than Joby’s – Joby’s was black and gray, while Tocad’s was black and ivory.

Further, to the extent that Joby is claiming that its trade dress is actually the type of product, *i.e.* a flexible tripod that can attach to various surfaces, “one supplier may not monopolize the configuration to the exclusion of others.” *Antioch*, 347 F.3d at 159. Indeed, “if the utilitarian aspects of the product *are its essence, only* patent law protects *its configuration* from use by competitors. *Global*, 417 F. Supp. 2d at 1168 (quoting *Clamp Mfg.*, 870 F.2d at 516 (emphasis added by *Global* court); *TrafFix*, 532 U.S. at 34 (“The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.”)).

It cannot seriously be disputed that the configuration of the Gorillapod is functional and that these functional features are precisely what Joby asserts are its trade dress and the features Joby touts in its advertising as the reason that the Gorillapod performs as it does.<sup>17</sup>

**b. The possible existence of alternative designs does not establish non-functionality**

Joby also claims that “the existence of alternative designs that perform the same function is persuasive evidence that Joby’s trade dress is non-functional.” (Dkt. 11 - PI Mem. at 15).<sup>18</sup> Joby then cites to two products that are “examples of different camera support designs,” but they are not flexible tripods that can “firmly secure your camera to just about anything—anywhere and everywhere.” (McMillion Decl., Ex. E) (www.joby.com). Hence, they are not truly “alternative designs that perform the same function.” Moreover, “[e]ven if there are alternative designs available in the marketplace, they cannot turn a feature that is functional under the traditional...definition into a non-functional feature which is the exclusive trade dress property of one seller.” *Antioch*, 347 F.3d at 155. If a feature is functional, it does not matter whether there are alternative designs available that perform the same function—the availability of alternative

<sup>17</sup> In his Declaration, Bevirt claims that the advertising and promotion “typically emphasizes the product’s fun, animal-like qualities.” (McMillion Decl., Ex. D, Bevirt Decl. ¶9). However, the only such reference on its website is to “Gorilla fun” and all other descriptions concern the functional features. As noted by the decision in *Leatherman*, *supra*, such limited reference to the look is not enough to overcome the functional claims.

<sup>18</sup> Notably, all alternative designs proposed by Tocad have been rejected by Joby. (McMillion Decl., Ex. H).



1 designs is irrelevant. “There is no need...to engage...in speculation about other design  
2 possibilities which might serve the same purpose where functionality is established.” *TrafFix*,  
3 532 U.S. at 33; *See also Antioch*, 347 F.3d at 155. Indeed, if the design is the reason that that the  
4 device works, “other designs need not be attempted.” *TrafFix*, 532 U.S. at 33-34.

5 Suggesting that Tocad could have had the ball and socket construction and covered the  
6 exterior, Joby asserts that “[n]or does the ball-and-socket construction of the Gorillapod dictate its  
7 shape...Ball-and-socket connectors can and do have many different *exterior* shapes, such as  
8 cylinders or cubes, or they can have small, compressed segments.” (Dkt. 11 - PI Mem. at 16).  
9 However, this argument is contrary to the Supreme Court’s decision in *TrafFix* where the Court  
10 noted that:

11 [b]ecause the dual spring design is functional, *it is unnecessary for*  
12 *competitors to explore designs to hide the springs, say by using a*  
13 *box or framework to cover them*, as suggested by the Court of  
14 Appeals. The dual-spring design assures the user the device will  
15 work. If buyers are assured the product serves its purpose by seeing  
the operative mechanism that in itself serves an important market  
need. *It would be at cross-purposes to those objectives, and*  
*something of a paradox, were we to require the manufacturer to*  
*conceal the very item the user seeks.*

16 *TrafFix*, 532 U.S. at 34 (emphasis added).

17 Hence, if the spherical ball and socket construction is functional, as it clearly is, Tocad  
18 would not have to “conceal” it and Joby’s argument regarding this type of “alternative design” is  
19 unfounded. Further, “the Ninth Circuit has stated that the availability of alternative designs ‘by  
20 itself is insufficient to prove non-functionality; there must be a sufficient number of alternative  
21 designs such that providing trademark protection to one design would not hinder competition.’”  
22 *Switchmusic.com*, 416 F. Supp. 2d at 820-21 (quoting *Disc Golf Ass’n*, 158 F.3d at 1008). At  
23 issue in *Switchmusic.com* was the alleged trade dress of a particular guitar design. The Defendant  
24 (who was claiming trade dress protection of its design) submitted a catalogue containing images  
25 of numerous guitars by various manufacturers and claimed that the catalogue showed that there  
26 are a wide variety of guitar body shapes and styles in the marketplace. The Court disagreed  
27 noting that “[o]n the contrary, the catalogue shows that there are a limited number of shapes and  
28 styles available for guitars. If Defendants were granted protection for their trade dress, it would

1 have the undesired effect of severely hindering competition by reserving a particular design for  
2 Defendants' exclusive use." *Id.* at 821.<sup>19</sup>

3 As noted, it is likely that much of Joby's argument will be premised on the allegation that  
4 Tocad copied the Gorillapod. However, even if true, it is well settled that unless protected by a  
5 patent or a copyright, "functional product features may be copied freely by competitors in the  
6 marketplace." *TrafFix*, 532 U.S. at 23. As the Court in *TrafFix* further noted:

7 *Trade dress protection must subsist with the recognition that in*  
8 *many instances there is no prohibition against copying goods and*  
9 *products. In general, unless an intellectual property right protects*  
10 *and item, it will be subject to copying. As the Court has explained,*  
*copying is not always discouraged or disfavored by the laws which*  
*preserve our competitive economy. Allowing competitors to copy*  
*will have salutary effects in many instances.*

11 *Id.* (emphasis added).

12 Indeed, "there is nothing inherently wrong" in copying a competitor's product. *Tie Tech,*  
13 *Inc. v. Kinedyne Corp.*, 296 F.3d 778, 785 (9th Cir. 2002). In fact, "a product's manufacturer  
14 'does not have rights under trade dress law to compel its competitors to resort to alternative  
15 designs which have a different set of advantages and disadvantages. Such is the realm of patent  
16 law.'" *Id.* at 786 (quoting *Leatherman*, 199 F.3d at 1014, n.7). Where the "overall design and  
17 appearance" was functional, "competitors thus had unrestrained permission to copy 'slavishly' or  
18 faithfully,' *id.* at 1012, n.4, those nonfunctional elements as copying 'preserves our competitive  
19 economy.'" *TrafFix*, 532 U.S. at 29. Based upon Joby's own statements in its utility patent  
20 applications, the statements Joby makes in its advertising and promotion and how the product is  
21 generally perceived, Joby cannot establish that its claimed trade dress is nonfunctional. Since  
22 there is nothing protectible about these features, competitors are free to copy them. *Bonito Boats,*  
23 *Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160 (1989); *TrafFix*, 532 U.S. at 29; *Eppendorf,*  
24 *289 F.3d at 355; Antioch*, 347 F.3d at 160. In this situation, the fact that Tocad may have copied  
25 the unprotected Gorillapod does not create liability.

26  
27 <sup>19</sup> Joby's argument on alternative designs also presents an interesting conundrum—  
28 on the one hand Joby asserts that the Flexpod Plus demonstrates the existence of "alternative  
designs" but yet Joby claims that the Flexpod Plus still infringes the Gorillapod trade dress.



c. **Joby's advertising touts the utilitarian features of the Gorillapod**

Not only do the product reviews tout the "utilitarian advantages of the design" but so does Joby in its own advertising. For example, on its website, Joby touts the "utilitarian advantages" of the rubberized ring and foot grips noting that they "provide extra gripping power to grapple wherever you want to go." (McMillion Decl., Ex. E). The website further emphasizes the operational advantages of the ball and socket design noting that "the flexible joints bend and rotate 360° to form the perfect shape" and that "you can bend and twist them so they'll always keep your camera steady." (McMillion Decl., Ex. E). Other Joby advertisements, specifically tout the functional features of its design, highlighting that the "RING & FOOT GRIPS provide extra gripping power to most surfaces" and the "FLEXIBLE JOINTS bend and rotate 360° to form the perfect shape." (McMillion Decl., Ex. V). Joby also consistently advertises the features of the Gorillapod in the following message:

The Joby Gorillapod is a bendable, flexible tripod that secures your camera to nearly any surface. Its legs bend and rotate 360 degrees, while its rubbery feet provide extra gripping power. You can wrap the Gorillapod around a tree branch, hang it from a railing, or perch it on a rock during your next hiking trip. The possibilities are endless!

(McMillion Decl., Ex. W). It is well settled that if a seller "advertises the utilitarian advantages of a particular feature this constitutes strong evidence of functionality." *Disc Golf Ass'n*, 158 F.3d at 1009. In *Switchmusic.com*, Defendants advertised their guitars "as giving the user an operational advantage that is not found in other guitars." *Switchmusic.com*, 416 F. Supp. 2d at 821. Here, the entire focus of the advertising of the Gorillapod is its "operational advantages," i.e. that it "firmly secures your camera to just about anything—anywhere and everywhere" and that "it is the only tripod malleable enough to provide you with the perfect shot while wrapped around a tree branch, hanging from a pole, or perched on a jagged rock." (McMillion Decl., Ex. F).

Significantly, in *Talking Rain*, which involved an analysis of the shape of a bottle for flavored and unflavored water, the Court found that "Talking Rain's advertising touts its bottle's

utilitarian features. Talking Rain, which refers to its bottle as the ‘Grip Bottle,’ argues that its ‘Get a Grip!’ slogan involves a double-meaning because the slogan is a slang expression meaning ‘get in control.’” The Court noted that “at least one meaning of its advertising is that the bottle is easy to grip. We are not required to ignore advertising that touts functional features just because those ads may include messages-subtle or otherwise-aimed at nonfunctional features.” *Talking Rain*, 349 F.3d at 603-04. Hence, that Joby may occasionally refer to the “fun” quality of the Gorillapod is not enough given all of the advertising and promotion which touts the functional features.

#### d. Summary

Joby hoists itself on its own petard by its claims in its utility patent applications, its statements in its advertising and promotion and the statements and arguments made by Joby in connection with its request for preliminary injunction. Put simply, the law mandates that Joby cannot have it both ways – *i.e.* claim that certain features are functional and entitle it to a utility patent and at the same time, try and use those same features to assert trade dress protection. The Court need look no further than Joby’s own statements to find that the features claimed as its trade dress are clearly functional and cannot be protected under principles of trademark law.

#### 2. Joby cannot establish secondary meaning

Since Joby cannot establish the non-functionality of its trade dress in the first instance, the Court need not even consider whether or not Joby can establish secondary meaning. Nonetheless, Joby’s trade dress claim fails on this element as well. As Joby correctly noted in its Preliminary Injunction Memorandum, to establish a protectible trade dress, Joby must demonstrate that the Gorillapod has acquired secondary meaning, that is, that the purchasing public associates the trade dress with a particular source. (Dkt. 11 - PI Mem. at 16-17). What Joby wholly failed to point out is that the product must have acquired the secondary meaning “*before* the defendant introduced its competing product.” *Global*, 417 F. Supp. 2d at 1171. *See also, Braun*, 975 F.2d at 826 (“A claim of trade dress infringement fails if secondary meaning did not exist before the infringement began.”); *Switchmusic.com*, 416 F. Supp. 2d at 821-22 (citing *Levi Strauss*, 778 F.2d

1 at 1358 for the proposition that plaintiff must show that its design obtained secondary meaning  
2 *before* defendant commenced its allegedly infringing activities).

3 As its “evidence” of secondary meaning, Joby relies on: (1) the alleged copying by  
4 Tocad; (2) instances of alleged confusion between Joby and Tocad’s products; (3) Joby’s eight  
5 month period of exclusivity (which Joby inaccurately repeatedly claims is “almost a year”); (4)  
6 Joby’s advertising expenditures; and (5) press coverage and product reviews of the Gorillapod.  
7 (*See e.g.* Dkt. 11 – PI Mem. at 16-18). None of these “facts” are sufficient to demonstrate that the  
8 Gorillapod obtained secondary meaning *prior to* the October 2006 introduction of the Tocad  
9 Flexpod.

10 First, even “proof of deliberate copying is not determinative of secondary meaning “as it  
11 does not necessarily establish that the copying is intended to confuse customers and capitalize on  
12 recognition of the plaintiff’s product.” *Walker & Zanger v. Paragon Indus., Inc.*, 2007 WL  
13 1302980, at \*11 (N.D. Cal. May 3, 2007). In *Walker & Zanger*, the Court also noted that  
14 “[c]ompetitors may intentionally copy product features for a variety of reasons; they may, for  
15 example, choose to copy design traits in response to consumer preference.” *Id.* Hence, the mere  
16 fact that Tocad may have copied the Gorillapod, without any evidence that Tocad intended to  
17 capitalize on the association with Joby, does not demonstrate secondary meaning. This is  
18 particularly true in this case where as Joby acknowledges, Tocad is a well known supplier (Tocad  
19 has a “more established network of distributors and retailers, built up over the company’s 20-year  
20 history.”) (Dkt. 11 - PI Mem. at 23). Moreover, the product packaging prominently displays the  
21 “Sunpak” brand name and the “Flexpod or Flexpod Plus” product name. (McMillion Decl., Ex.  
22 P).<sup>20</sup>

23 Second, all of the alleged instances of confusion relied upon by Joby as support for  
24 secondary meaning obviously occurred after Tocad’s entry into the market in October 2006 –  
25 indeed, significantly after: February 2008, summer 2007 and August 2007. (Dkt. 11 – PI Mem.

26  
27 <sup>20</sup> Joby attempts to attribute some significance to the fact that both the Joby and Tocad  
28 products are displayed in clear packaging. (Dkt. 11 - PI Mem. at 6). Many small consumer products,  
especially small electronics and accessories are displayed in see-through packaging. (McMillion Decl.,  
Ex. X)

at 17; Waddell Decl. ¶¶ 3, 4, 5). Hence, these instances of alleged confusion cannot provide a basis for a determination of whether or not the Gorillapod had acquired secondary meaning by October 2006. Third, Joby has not provided any evidence that in the eight month period of exclusivity, the Gorillapod acquired secondary meaning. In fact, such a short period before the introduction of competing products is “evidence point[ing] strongly away from a finding of secondary meaning.” *Braun*, 975 F.2d at 826 (quoting *Cicena, Ltd. v. Columbia Telecommunications Group*, 900 F.2d 1546, 1552 (Fed Cir. 1990)). In both *Braun* and *Cicena* eighteen months was not sufficient for the products to acquire secondary meaning. Indeed, as the Court noted in *Braun* “while not impossible, it is difficult for a product to acquire secondary meaning during an 18-month period.” *Id.* See also *Keystone Camera*, 667 F. Supp. at 1231 (14 months “so short-lived that secondary meaning could not have been established”); *Global*, 417 F. Supp. 2d at 1171 (“very brief time” of four to six months that Plaintiff’s scooter was on the market made it “highly unlikely that the purchasing public would have formed a mental association between the overall shape of the Q scooter and the Plaintiff as ‘the’ source.”).

Fourth, while the Bevirt Declaration asserts that during the “first nine months after launch of the Gorillapod, we promoted the product at four trade shows and spent approximately \$178,000 on advertising and promotion in print and in other media,” (McMillion Decl., Ex. D, Bevirt Decl. ¶ 11), the bulk of those expenditures occurred after the Tocad Flexpod’s October 2006 entry in the market and likely in anticipation of the holiday marketing season. (McMillion Decl., Ex. Y). Prior to October 2006, Joby had only spent approximately **REDACTED** in advertising and promotional expenses. (McMillion Decl., Ex. Y).<sup>21</sup> Moreover, not only did Joby spend very little in advertising during this exclusive period, but it is not the amount of advertising or the amount of money spent on advertising that is probative; rather it is how effective the advertising is to creating secondary meaning. *Braun*, 975 F.2d at 826-27 (“the fact that Braun spent an arguably large sum of money on advertising is of limited probative value. Braun did not proffer

<sup>21</sup> Despite Bevirt’s claims at spending \$178,000 in advertising, the Income Statements for Joby show only **REDACTED** spent on marketing and trade shows from January 2006 to September 2006. (See McMillion Decl. ¶26, Ex.Y). In any event, according to the Bevirt Declaration, Joby spent at most \$178,000 prior to the introduction of the Tocad Flexpod. **REDACTED**

1 evidence establishing that the advertising effectively created secondary meaning as to the  
2 blender.”); *Continental Lab.*, 114 F. Supp. 2d at 1000 (“A large expenditure of money does not in  
3 itself create legally protectable rights. The test of secondary meaning is the effectiveness of the  
4 effort to create it.”).

5 Moreover, the press coverage and reviews of the Gorillapod are also not probative of  
6 whether or not the Gorillapod had attained secondary meaning at the time of the Tocad Flexpod  
7 entry in October 2006. In *Braun*, the Court noted that “Braun’s limited evidence as to  
8 advertising, sales and media attention, standing alone, is not sufficient to demonstrate that the  
9 consuming public identified the blender design with its maker, Braun.” *Braun*, 975 F.2d at 826.  
10 Commenting on the existence of product reviews, in *Switchmusic.com*, the Court noted that  
11 “these reviews fail to show that Defendants acquired secondary meaning in their trade dress.  
12 They are merely reviews concerning the attributes of Parker guitars.” Additionally, the press  
13 coverage that occurred before October 2006 does not support an inference of secondary meaning.  
14 Those product reviews and articles primarily address the functional features of the Gorillapod.  
15 They tout the utilitarian advantages of the design, but do not stress the color, shape, or “overall  
16 look.” See *First Brands Corp. v. Fred Myer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987)  
17 (advertising campaign failed to establish secondary meaning because it did not attempt to  
18 engender consumer identification or urge consumers to look for the color or shape of the  
19 product).

20 Finally, much of the press coverage and reviews which Joby relies on occurred after the  
21 entry of the Tocad Flexpod. (See McMillion Decl., Ex. D, Bevirt Dec. ¶10, Ex. G & H). Any  
22 media attention after October 2006 has no legal relevance to secondary meaning. *Continental*  
23 *Labs*, 114 F. Supp. 2d 992 at 1001-1002. (Advertisements running after the alleged infringing  
24 activity began lack any legal relevance to the question of secondary meaning).

25 For these reasons, Joby is unable to demonstrate that the Gorillapod has acquired  
26 secondary meaning.

### III. CONCLUSION

This is a straightforward trade dress case involving a simple product, a flexible tripod – a product which Joby introduced into the market only months before other manufacturers released their products. Joby's Gorillapod and the Tocad Flexpod may look similar, but Joby's claims of trade dress infringement are legally deficient because the Gorillapod does not have a protectible trade dress. Joby cannot prove that its alleged trade dress is non-functional. It has sought patent protection on the very features which it now claims as a distinctive trade dress. Given the functionality of Joby's Gorillapod, the Court does not have to even consider if it has attained secondary meaning. Nonetheless, Joby is unable to prove that element as well.

Consequently, for the foregoing reasons, Tocad is entitled to judgment as a matter of law and respectfully requests that this Court grant its Motion for Summary Judgment.

Date: June 20, 2008

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